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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,396	09/27/2001	Henry H. Smith	3691-311	1122

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EXAMINER

LEE, EDMUND H

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,396

Applicant(s)

SMITH ET AL.

Examiner

EDMUND H. LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 29 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6319438 (hereinafter USPN '438). Although the conflicting claims are not identical, they are not patentably distinct from each other because USPN '438 teaches the basic claimed process including extruding a colored layer including metallizing material. It is well-known in the molding art and automotive art not to use a metallizing material in a colored layer in order to create a non-metal appearance. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to not include metallizing material in the colored layer of USPN '438 in order to form a trim having a non-metallic appearance.

3. Claim 33 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6319438 (hereinafter USPN '438). Although the conflicting claims are not identical, they are not

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patentably distinct from each other because USPN '438 teaches extruding an approximately planar sheet; extruding a colored layer including metallizing material; and providing a clear coat of thermoplastic fluorinated polymer. USPN '438 does not teach a tie layer including color pigment material therein. In regard to extruding an approximately planar sheet, it is well-known in the molding art not to extrude an approximately planar sheet. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to not extrude an approximately planar sheet in order to reduce stress upon the layer during 3D vacuum forming. In regard to extruding a colored layer including metallizing material, it is well-known in the molding art and automotive art not to use a metallizing material in a colored layer in order to create a non-metal appearance. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to not include metallizing material in the colored layer of USPN '438 in order to form a trim having a non-metallic appearance. In regard to providing a clear coat of thermoplastic fluorinated polymer, it is well-known in the molding art and automotive art to use clear coats of other than thermoplastic fluorinated polymer. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a clear coats of other than thermoplastic fluorinated polymer in order to reduce material costs. In regard to a tie layer including color pigment material therein, such is well-known in the molding art in order to enhance the aesthetic appeal of a molded trim. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a tie

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layer with color pigment therein in order to enhance the aesthetic appeal of the molded trim.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 33,34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0864417 A2. EP 0864417 A2 teaches the claimed process as evidenced by pgs 3-7.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roys et al (USPN 6284183) in view of Johnson et al (USPN 5518786). In regard to claim 29, Roys et al teach the basic claimed process including a method of making a colored automotive trim product (abstract; col 4, lns 22-26,45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8); extruding an approximately planar sheet including a colored layer including color pigment (abstract; col 4, lns 22-26,45-46 and

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53-55; col 5, Ins 47-50; col 6, Ins 1-3; col 9, Ins 1-2; figs 1-8); providing a substantially transparent clear coat layer comprising a thermoplastic fluorinated polymer over the colored layer (abstract; col 4, Ins 22-26,45-46 and 53-55; col 5, Ins 47-50; col 6, Ins 1-3; col 9, Ins 1-2; figs 1-8); positioning the substantially transparent clear coat layer together with the colored layer in a vacuum forming apparatus (abstract; col 4, Ins 22-26,45-46 and 53-55; col 5, Ins 47-50; col 6, Ins 1-3; col 9, Ins 1-2; figs 1-8); vacuum forming the clear coat layer together with the colored layer into a three dimensionally shaped preform (abstract; col 4, Ins 22-26,45-46 and 53-55; col 5, Ins 47-50; col 6, Ins 1-3; col 9, Ins 1-2; figs 1-8); and utilizing the three dimensionally shaped preform as at least a portion of an exterior trim product for a vehicle (abstract; col 4, Ins 22-26,45-46 and 53-55; col 5, Ins 47-50; col 6, Ins 1-3; col 9, Ins 1-2; figs 1-8). Roys et al, however, do not teach providing at least one tie layer between the colored layer and the substantially transparent clear coat layer. Johnson et al teaches molding an exterior automotive laminate wherein the laminate includes a tie layer between a color layer and a clear coat (figs 1-5). Roys et al and Johnson et al are combinable because they are analogous with respect to molding exterior automotive laminates. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a tie layer as taught by Johnson et al between the colored layer and clear coat layer of Roys et al in order to enhance the bonding between the layers. In regard to claims 30-31, such is taught by Roys et al (abstract; col 4, Ins 22-26,45-46 and 53-55; col 5, Ins 47-50; col 6, Ins 1-3; col 9, Ins 1-2; figs 1-8). In regard to claim 32, Roys et al teach an extruded TPO substrate of different material than the colored layer (examples

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1-3). Roys et al, however, do not teach an injection molded base layer but injection molded base layers are well-known in the molding art and automotive art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to injection mold the base layer of Roys et al since extruded base layers and injection molded bases layers are well-known as substitutable alternatives.

8. Claims 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roys et al (USPN 6284183) in view of EP 0864417 A2. In regard to claim 33, Roys et al teach the basic claimed process including a method of making a colored automotive trim product (abstract; col 4, lns 22-26,45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8); extruding a colored layer including color pigment (abstract; col 4, lns 22-26,45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8); providing a substantially transparent clear coat layer over the colored layer (abstract; col 4, lns 22-26,45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8); positioning the substantially transparent clear coat layer together with the colored layer in a vacuum forming apparatus (abstract; col 4, lns 22-26,45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8); vacuum forming the clear coat layer together with the colored layer into a three dimensionally shaped preform (abstract; col 4, lns 22-26,45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8); and utilizing the three dimensionally shaped preform as at least a portion of an exterior trim product for a vehicle (abstract; col 4, lns 22-26,45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8). Roys et al, however, do not teach providing at least one tie layer between the colored layer and the substantially transparent clear coat

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layer, wherein the tie layer includes color pigment material therein. EP 0864417 A2 teaches molding an exterior automotive laminate wherein the laminate includes a tie layer having colored pigment therein between a color layer and a clear coat (pgs 3-7).

Roys et al and EP 0864417 A2 are combinable because they are analogous with respect to molding exterior automotive laminates. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a tie layer having color pigment material therein as taught by EP 0864417 A2 between the colored layer and clear coat layer of Roys et al in order to enhance the bonding between the layers. In regard to claims 34-36, such is taught by Roys et al (abstract; col 4, lns 22-26, 45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8).

9. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0864417 A2 in view of Roys et al (USPN 6284183). The above teachings of EP 0864417 A2 are incorporated hereinafter. EP 0864417 A2 does not teach using a thermoplastic fluorinated polymer for the clear coat. Roys et al teach a clear coat layer comprised of thermoplastic fluorinated polymer (abstract; col 4, lns 22-26, 45-46 and 53-55; col 5, lns 47-50; col 6, lns 1-3; col 9, lns 1-2; figs 1-8). Roys et al and EP 0864417 A2 are combinable because they are analogous with respect to molding exterior automotive laminates. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use thermoplastic fluorinated polymer as the clear coat layer of EP 0864417 A2 in order to provide strength and durability.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is

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571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY
FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE
Primary Examiner
Art Unit 1732

EHL



10/1/04